

AMENDMENT UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/657,272

REMARKS

Claims 1, 3-6, 8-17, 19-22 and 24-38 are all the claims pending in the application.

In response to the Amendment filed June 14, 2004, the Examiner has removed all of the previous prior art rejections. However, the indefiniteness rejection has been repeated. The status of the claims is the following.

Claims 1, 3-6, 8-17, 19-22, and 24-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claims 1, 3-6, 8, 10, 11, 17, 19-22, 24, 26, 27, 36 and 37 are rejected under 35 U.S.C. § 102(e) as being anticipated by newly-cited Stevenson et al. (US 6,393,161).

Claims 33 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by newly-cited Denber (US 5,214,470).

Claims 9 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson in view of previously-cited Sugiura et al. (US 6,034,766).

Claims 12 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson in view of Denber.

Claims 13, 14, 29, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson in view of previously-cited LeCouteur (GB 1547811).

Claims 15, 16, 31, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson in view of LeCouteur, and further in view of Sugiura et al.

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Denber in view of LeCouteur.

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Claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Denber in view of LeCouteur, and further in view of Sugiura et al.

With regard to the rejection of the claims under 35 U.S.C. § 112, second paragraph, by the present Amendment, Applicant seeks to amend claims 1, 4, 5, 14, 16, 17, 19, 20, 32 and 33. Claims 36-38 are canceled. These amendments are believed to fully address the rejection. For example, the portion of claims 1 and 17 which recited that the one-dimensional reading is continued during the scanning was replaced by the recitation of scanning in a first direction and simultaneously reading one-dimensionally in a second direction. Also, claims 1 and 17 are amended to change “reading a specified detecting light by scanning the detecting light” to “scanning a specified detecting light.” This amendment simplifies the claim language.

Turing to the prior art, Applicant has the following comments.

Stevenson relates to a method for operating a document handler for causing an image-bearing sheet to pass over a light-transmissive window in a process direction for recording by a photosensitive member.

Denber relates to a method and apparatus for identifying and compensating for dirt or etched areas on a document platen.

Claims 1, 3-6, 8, 10, 11, 17, 19-22, 24, 26, 27, 36 and 37 are rejected as being anticipated by Stevenson. With regard to claim 1 of the present application, Applicant seeks to add the feature of “after a focusing position of the specified detecting light is set on a position of an optical element disposed in the optical path of the visible light, the focusing position being different from a position of the image recording medium” in line 7 of claim 1. Also, “an optical

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element disposed in the optical path of the visible light” in lines 12-14 of claim 1 is replaced with “the optical element.”

Stevenson discloses an image correcting method by a spot of dirt attached to a window 12. When the correction is performed in Stevenson’s apparatus, since roller 10 to drive an original image is placed in very close proximity to the top surface of window 12 as shown in Fig. 1 and described in column 3, lines 10-12, the original image and the surface of the window 12 are at substantially the same position. Thus, the focus when focusing on the original image for reading comes into the surface of the window 12. This is also same in the cited reference of Denber (see Fig. 1). Thus, Stevenson fails to teach or suggest the feature of claim 1 of after a focusing position of the specified detecting light is set on a position of an optical element disposed in the optical path of the visible light, the focusing position being different from a position of the image recording medium. Therefore, Applicant submits that claim 1 is not anticipated by Stevenson.

Applicant submits that claims 3-6, 8, 10 and 11 are not anticipated by Stevenson, at least because of their dependence from claim 1.

With further regard to claim 5, Applicant submits that Stevenson does not disclose the features of this claim. Claim 5 recites wherein the scanning is performed by transferring a mirror reflecting the specified detecting light in the optical path. The Examiner asserts that Stevenson discloses this feature at col. 3, lines 16-21. Applicant disagrees. The cited excerpt discloses the use of a mirror 14, but the excerpt does not disclose transferring the mirror. Accordingly, claim 5 is not anticipated for this additional reason.

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Claim 17 is amended in a similar manner to that of claim 1. Applicant submits that claim 17 and its dependent claims 19-22, 24, 26 and 27 are not anticipated by Stevenson for reasons analogous to those for claim 1.

Claims 9 and 25 are rejected as being unpatentable over Stevenson in view of Sugiura. Applicant submits that claims 9 and 25 are allowable over the prior art, at least because of their dependence from claims 1 and 17, respectively, and because Sugiura fails to make up for the above-described deficiencies of Stevenson.

For the rejection of claims 12 and 28 over Stevenson in view of Denber, Applicant submits that claims 12 and 28 are allowable at least because of their dependence from claims 1 and 17, respectively, and because Denber does not make up for the above-described deficiencies of Stevenson.

Also, claims 13, 14, 29 and 30 are allowable over the prior art, at least because of their dependence from claims 1 and 17, respectively, and because LeCouteur fails to make up for the deficiencies of Stevenson.

Claims 15, 16, 31 and 32 are rejected as being unpatentable over Stevenson in view of LeCouteur, and further in view of Sugiura. Applicant submits that these claims are allowable over the prior art, at least because of their dependence from claims 1 and 17, respectively, and because LeCouteur and Sugiura do not make up for the above-described deficiencies of Stevenson.

Furthermore, there is no suggestion or motivation to combine the references. The Examiner asserts that it would have been obvious to modify LeCouteur by adding the focusing capabilities taught in Sugiura, because the ability to focus the image allows for the best and most

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accurate detection of scratches and foreign matter. However, the Examiner's asserted motivation to combine the references is not particular to the cited references. Rather, the ability to focus the image is simply a generally desirable feature in an imaging system. There is no particular suggestion or motivation within the references to make the modification suggested by the Examiner. Thus, claims 15, 16, 31 and 32 are allowable for this additional reason.

Additionally, Applicant submits that the prior art fails to teach or suggest all of the limitations of claims 15, 16, 31 and 32.

In particular, the prior art does not disclose focusing positions of a specified detecting light and an invisible light being different from one another, as recited in claim 15. In fact, the Examiner has not even asserted that the references disclose this feature. Hence, claim 15 is allowable for this reason also.

Claim 16 recites that the specified detecting light is identical to the invisible light, and focusing positions of the invisible light are different from one another between the time when at least one of the foreign matter and the scratch on the optical element disposed in the optical path is detected by the invisible light and the time when at least one of the foreign matter and the scratch on the image recording medium is detected by the invisible light. This recitation is more specific than the general disclosure in Sugiura of focusing an imaging lens. See col. 9, lines 17-19. Thus, claim 16 is allowable for this additional reason.

Recited in claim 31 is a second changing device for changing focusing positions of the specified detecting light and the visible light in accordance with whether at least one of the foreign matter and the scratch in the optical element is detected by the invisible light or at least one of the foreign matter and the scratch on the image recording medium is detected by the

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invisible light. Sugiura simply discloses focusing an imaging lens. In other words, Sugiura does not disclose changing focusing positions of the specified detecting light and the visible light in accordance with whether at least one of the foreign matter and the scratch in the optical element is detected by the invisible light or at least one of the foreign matter and the scratch on the image recording medium is detected by the invisible light. Accordingly, claim 31 is allowable for this reason as well as the above-described reasons.

Claim 32 is allowable for analogous reasons to those for claim 31.

Claim 33 is rejected as being anticipated by Denber. Claim 34 is rejected as being unpatentable over Denber in view of LeCouteur. Claim 35 is rejected as being unpatentable over Denber in view of LeCouteur and Sugiura. By the present amendment, Applicant seeks to amend claim 33 to include the limitations of claims 34 and 35.

In conjunction with this amendment, Applicant submits that the prior art fails to teach or suggest all of the limitations of amended claim 33. Specifically, the prior art does not disclose the feature of amended claim 33 of wherein, in the first detecting step, a focusing position of the invisible light is set on the image recording medium, and in the second detecting step, the focusing position of the invisible light is changed from the image recording medium. The Examiner asserts that Sugiura discloses this feature of the claim, but Applicant disagrees. The portion of Sugiura referred to by the Examiner makes the general disclosure of an imaging lens for focusing with respect to a line sensor. However, the reference does not disclose the above-recited specific features of claim 33. Thus, claim 33 is allowable over the prior art.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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